

REMARKS

The Office Action dated May 18, 2004 has been carefully considered. Applicants thank the Examiner for the courtesies extended during a recent interview. Claims 1, 4, 6, 19 and 20 have been amended. Claims 5 and 21 have been cancelled. Claims 1, 2, 4 and 6-20 are in this application.

The previously-presented claims 1 and 4, 6-8, 11-16 and 18-20 were rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 3,199,394 to Castelli. Applicants submit that the teachings of this reference does not teach or suggest the invention defined by the present claims.

The Examiner alleges that Castelli discloses Applicants' present invention and that although Castelli does not disclose a material which provides an attractive cling, the rails of Castelli inherently has the same properties as the disclosed invention. Applicants respectfully traverse.

A 35 U.S.C. § 102(b) rejection is only proper when directed toward an invention that is identically disclosed or identically described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of application for patent in the United States. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single reference." Verdegaal Bros v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

Castelli does not disclose the limitation "plastic wrap." Thus, the present invention is not anticipated by Castelli because Castelli does not identically disclose or identically describe the invention.

Further, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing

descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id.

The Examiner alleges that an attractive cling is provided to the film because the rails are made of plasticized polyvinyl chloride, which inherently holds a charge that provides a clinging force. Also, the Examiner alleges evidence that polyvinyl chloride provides a charge and a clinging force is shown in sections 16.1-16.4 of Boston University's Physics web page.

Applicants wish to direct the Examiner's attention to sections 16.1-16.4 of Boston University's Physics web page. In these sections, rubber, wood, and plastics (i.e., PVC) are insulators. Insulators, as defined in these sections, have their electrons more tightly bonded to their atoms and are not free to flow. This property inhibits conduction and thus the transfer of electric charge.

However, the sections of the Boston University's Physics web page state that to induce a net charge on an insulator a second material must be rubbed with the insulator (i.e., charging by friction). The example cited in sections 16.1-16.4 is a plastic ruler with a piece of paper towel.

Also, the reference states that these charges are prone to removal, particularly in humid conditions. Further, those skilled in the art would recognize that the net charges can be removed or neutralized through continuous contact and removal with oppositely charged materials. Therefore, once the net charge is removed from the insulator, particularly the PVC rail of Applicants' invention, the PVC rail will no longer have the "inherent" attractive property to attract the film. To re-establish a net charge, a second material would need to be subsequently rubbed against the rail.

Applicants' invention is not directed to having or needing an induction of a net charge to enable the film to adhere to the base rail nor is the attractive property of the rail removed under humid conditions. As described in the enclosed Declaration of Paul Vegliante, it is known and understood by those skilled in the art that plasticized PVC comprising 10% or more of plasticizers provide an attractive cling property. Cling is defined as follows: In the case of plasticized films, cling and blocking are synonymous. This cling is due to the addition of plasticizer as a result of: (1) smooth surfaces adhere more readily to one another. The addition

of plasticizer tends to result in smoother surfaces; (2) plasticizer increases the amorphous content which increases blocking; (3) clean identical flexible PVC surfaces readily wet one another resulting in increased cling; and (4) other secondary mechanisms that increase cling are lowering of the melting point of the resin and increased flow under pressure due to plasticizer addition, as described in *The Technology of Plasticizers* by J. Kern Sears and Joseph R. Darby, John Wiley and Sons ISBN 0-471-05583-2, page 461. In the case of PVC plasticized films, plasticized PVC having less than 10% plasticizer is a rigid material without plasticization effects of being flexible, as further referenced on enclosed pages 304-307 of the *Technology of Plasticizers*, J. Kern Sears and Joseph R. Darby, John Wiley and Sons, NY, ISBN 0-471-05583-2. Further, as a result of this percentage of plasticizers, the plasticized PVC is flexible and non-rigid, which is greater than the claimed range of 10% plasticizers. An example of a material having greater than 10% plasticizer is described as Teknor Apex, page 5, lines 19-23 of the present application. As shown on the enclosed data sheet for the Apex material, Apex has a 30% to 35% plasticizer (DEHP).

In contrast, Castelli does not disclose that the tape cutter is flexible, or is formed of plasticized PVC comprising 10% or more plasticizers having a cling property. Rather, if the tape cutter of Castelli were formed of plasticized PVC comprising 10% or more plasticizers, the plasticized PVC would compromise the structural integrity of the tape cutter because it would be flexible. The flexibility would compromise the tape cutters intended use of being held in a user's hand and securely holding and dispensing several roles of tape. As understood by those skilled in the art, the Castelli device must be formed of material that is rigid. Also, if the tape cutter of Castelli were formed of plasticized PVC having a cling property, the Castelli tape cutter would have the non-desirable property of having material cling to it. Not only would material cling to the base rail for cutting tape, but material would cling to every portion of the tape cutting device of Castelli. Further, Castelli teaches that suitable materials for forming the tape dispenser device are polypropylene, polyethylene and plasticized PVC. However, because polypropylene and polyethylene do not have a cling property, Castelli does not make clear that the "cling" property of plasticized PVC is necessarily present and that any inherent "cling" property of plasticized PVC would be so recognized by persons skilled in the art.

Accordingly, the Examiner has failed to provide objective evidence of cogent technical reasoning to support the conclusion of inherency.

Further, Castelli discloses, in column 1, lines 17-35, a tape dispenser for handling several rolls of tape that is made from a single casting or molding operation. The tape dispenser which will hold a plurality of rolls of adhesive tape is adapted to be held in the hand while removing and severing tape sections. Further still, Castelli discloses, in column 2, lines 13-35, that body section 15 has raised spacers 19, 20 and 21, all integrally molded therewith. These spacers serve to support a removable spindle 22 and also position the rolls 37 of tape so that sections of tape withdrawn there from can be readily cut. Also, spacers 19 and 21 are spaced respectively from ends 13 and 14 to permit the cutter 21 to travel completely across a withdrawn section of tape. Spacers 19, 20 and 21 also keep the respective adhesive tapes separate from one another.

Those skilled in the art would recognize that to maintain the integrity of the tape dispenser, the tape dispenser would need to be formed of a material sufficiently rigid to support and allow the rolls of adhesive tape to be dispensed while being held in a person's hand and would have a percentage of plasticizer of less than 10%. Furthermore, spacers 19, 20 and 21 need to be sufficiently rigid to allow them to support the removable spindle that is holding a plurality of rolls of tape. Those skilled in the art would recognize that any flexible plastic material would compromise the ability of the Castelli tape dispenser to support the spindle which is weighted down by the plurality of rolls of tape. Also, if spacers 19, 20 and 21 were formed of a flexible plastic, through frequent use they would bend and in turn compromise and interfere with the turning and dispensing of the tape. Therefore, those skilled in the art would know and understand that a solid, nonflexible and rigid plastic material, such as polypropylene and polyethylene, or plasticized polyvinyl chloride having a degree of plasticization to provide a rigid material would be needed, similar to the plastics conventionally used in tape dispensers to dispense transparent tape.

Furthermore, Castelli teaches that the tape dispenser can be formed of polypropylene and polyethylene. Applicants submit that polypropylene and polyethylene are rigid materials which do not have a cling property. Accordingly, not all the materials described by Castelli could have a cling property and it is not inherent to that the Castelli device would have a cling property, but rather only a possibility. Applicants submit that one of ordinary skill in the art would not

recognize which of the materials that are described for making the Castelli tape dispenser could have a cling property.

Thus, Castelli actually teaches away from the use of flexible plastic materials, such as plasticized polyvinyl chloride, and therefore the claims of the present invention are not obvious in view of Castelli.

With regard to claim 7, Applicants submit that there is no teaching or suggestion in Castelli of the combination of two different materials using co-extrusion for use in a slide cutter. The present invention combines a first material for providing an attractive property and a second material for providing functionality of the rail. There is no teaching or suggestion in Castelli to use co-extrusion to provide a slide cutter providing dual properties for both holding plastic wrap and strength of the rail.

Claim 2 was rejected under 35 U.S.C. § 103(a) as obvious in view of Castelli in combination with U.S. Patent No. 4,960,022 to Chuang.

Chuang discloses a plastic film cutter using rollers for engaging and maintaining the film in a tensioned state. The cutter has a concave surface.

In contrast to the invention defined by the present claims, Chuang does not teach or suggest rails being formed of a material providing an attraction to film received over the rails to cling the plastic wrap before and after cutting of the plastic wrap. Rather, Chuang uses rollers for engaging and maintaining the film in a tensioned state. Thus, Chuang does not cure the deficiencies of Castelli, as noted above. Accordingly, the invention defined by the present claim 2 is not obvious in view of Castelli in combination with Chuang.

Claim 9 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Castelli in view of U.S. Patent No. 4,202,233 to Larson.

Larson discloses a saw guide device for a hand powered saw. A guide bar extends across a work piece. The material of the base is constructed of a material different from the guide bar to reduce sliding friction between the guide bar and the base pod.

In contrast to the invention defined by the present claims, Larson does not teach or suggest rails being formed of a material providing an attraction to plastic wrap received over the rails to hold the film before and after cutting of the film. Instead, Larson is directed to a tool guide for a saw guide and is unrelated to a film cutter apparatus. Moreover, there is no teaching


or suggestion of a base formed of a material providing an attraction for clinging of a plastic wrap to a pair of rails. Accordingly, Larson does not cure the deficiencies of Castelli noted above.

Claim 17 was rejected under 35 U.S.C. § 103(a) as obvious in view of Castelli. Castelli discloses body section 15 includes raised spacers 19, 20 and 21 to support removable spindle 22 and position roles of tape 37 to be cut by cutter 12. In contrast to the invention defined by the present claims, Castelli does not teach or suggest end caps attached to ends of the base rail. Further, Castelli does not disclose or suggest that the end caps would release upon application of excessive force. In addition, in contrast to the invention defined by the present claims as noted above, Castelli does not teach or suggest rails being formed of a material providing an attraction to plastic wrap received over the rails to cling the plastic wrap to the rails before and after cutting of the plastic wrap. Accordingly, the invention defined by the present claim 17 is not obvious in view of Castelli.

In view of the foregoing, Applicants submit that all pending claims are in condition for allowance and request that all claims be allowed. The Examiner is invited to contact the undersigned should he believe that this would expedite prosecution of this application. It is believed that no fee is required. The Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 13-2165.

Respectfully submitted,

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Diane Dunn McKay
Reg. No. 34,586
Attorney for Applicant

MATHEWS, COLLINS, SHEPHERD & MCKAY, P.A.
100 Thanet Circle, Suite 306
Princeton, NJ 08540
Tel: 609 924 8555
Fax: 609 924 3036